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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/735,929	12/16/2003	Shinichi Kawamura	246510US0DIV	4254
22850	7590	01/03/2005		
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER RODEE, CHRISTOPHER D	
			ART UNIT	PAPER NUMBER
			1756	

DATE MAILED: 01/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/735,929

Applicant(s)

KAWAMURA ET AL.

Examiner

Christopher RoDee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 37-58 is/are pending in the application.
- 4a) Of the above claim(s) 44-51 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 52-58 is/are allowed.
- 6) ☒ Claim(s) 37-39 is/are rejected.
- 7) ☒ Claim(s) 40-43 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of group I, claims 37-43 and 52-58 in the reply filed on 18 November 2004 is acknowledged. The traversal is on the ground(s) that the Examiner has not provided reasons and/or examples to support the conclusions of separate utility for Groups I and II or another method of use for Group III as compared to the other groups. This is not found persuasive because the Examiner has provided specific alternative utility and other processes of use. Applicants have not disputed that the alternatives presented in the restriction are not feasible. The Examiner has provided examples and reasons to support distinctness and separate patentability.

The requirement is still deemed proper and is therefore made FINAL. Rejoinder for the non-elected process (Group III) will be considered when the elected invention is found allowable. However, the invention of Group II is not subject to rejoinder because it is not related as a process of making or using the elected product. The Examiner suggests that the claims of Group II be canceled to expedite prosecution.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tachikawa *et al.* in US Patent 5,069,992.

Tachikawa discloses an electrophotographic printing plate precursor having an electroconductive support and a photoconductive layer thereon. The photoconductive layer contains an alkali-soluble polyurethane resin (Abstract). The polyurethane is formed by the reaction of a diisocyanate of the formula (I) and a carboxyl group-containing diol given by the formula (II), (III), or (IV) (col. 3, l. 17-45). In formula (II)  $R_3$  and  $R_4$  can be divalent aromatic hydrocarbon groups,  $R_2$  is a  $C_{1-8}$  alkyl group, and  $R_5$  is a  $C_{1-20}$  alkylene group. Polyurethane (60) is formed using a diol having phenyl groups as aromatic hydrocarbon groups. The photoconductive layer can have a charge generation compound and a charge transport compound in the same layer or different layers (col. 12, l. 16-27). Various additives can be present in the photoconductive layer, such as a plasticizer or a matting agent, which meets the requirements of a filler in the claims (col. 12, l. 52-61).

Tachikawa differs from the instant claims because Tachikawa's  $R_2$  is a  $C_{1-8}$  alkyl group while the corresponding group in the instant claims must have from 9 to 28 carbons.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to select  $R_2$  as a  $C_9$  alkyl group because the artisan would have found alkyl compounds differing by only one carbon atoms in its chain from the reference's disclosure to have substantially the same properties. This is particularly the case in Tachikawa because the reference discloses  $R_5$  as a  $C_{1-20}$  alkylene group, which suggests that long chain alkyl groups are effective. The use of phenyl for  $R_3$  and  $R_4$  would have been obvious given the general guidance of a  $C_6$  arylene and the use of phenyl in the same positions in polyurethane 60's diol.

#### ***Terminal Disclaimer***

The terminal disclaimer filed on 18 November 2004 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US

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Patent 6,548,216 has been reviewed and is accepted. The terminal disclaimer has been recorded.

***Allowable Subject Matter***

Claims 40-43 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 52-58 are allowed.

***Conclusion***

All previously applied grounds of rejection have been withdrawn based on the claim amendments.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher RoDee whose telephone number is 571-272-1388. The examiner can normally be reached on most weekdays from 6:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cdr  
28 December 2004



**CHRISTOPHER RODEE**  
**PRIMARY EXAMINER**